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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/016,686	11/02/2001	Susan Mary Kingsman	674523-2012	4344
20350	7590	09/27/2004	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			HELMS, LARRY RONALD	
			ART UNIT	PAPER NUMBER
			1642	

DATE MAILED: 09/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/016,686

Applicant(s)

KINGSMAN ET AL.

Examiner

Larry R. Helms

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 52-54, 57, 60-66 and 68 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 52-54, 57, 61, 63, 65, 66 and 68 is/are allowed.
- 6) ☒ Claim(s) 60, 62 and 64 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-51, 55-56, 58-59, 67, 69-95 are canceled.
Claims 52-54, 57, 60-66, 68 have been amended.
2. Claims 52-54, 57, 60-66, 68 are under examination.
3. The text of those sections of Title 35 U.S.C. code not included in this office action can be found in a prior Office Action.

NOTE: The inventor Alan Kingsman has been deleted from the inventors and the last name of Carroll has been corrected.

Rejections withdrawn

4. The rejection of claims 52, 68 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention is withdrawn in view of the amendments to the claims.
5. The rejection of claim 54, 60-66 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement is withdrawn in view of the amendment to the claims.
6. The rejection of Claims 51-52, 54, 61, 63, 65-66 under 35 U.S.C. 112, first paragraph, is withdrawn in view of the amendments to the claims.

7. The rejection of claims 51-52, 54, 60-67 under 35 U.S.C. 102(b) as being anticipated by Chaudhary et al (PNAS 87:1066-1070, 1990) is withdrawn in view of the amendments to the claims.
8. The rejection of claim 60 under 35 U.S.C. 102(b) as being anticipated by The Promega 1993/94 catalog of nucleic acids, page 215-216 is withdrawn in view of the amendments to the claim.
9. The rejection of claims 51-52, 54, 60-67 under 35 U.S.C. 102(e) as being anticipated by Chester et al (US Patent 5,876,691, filed 7/96) is withdrawn in view of the amendments to the claims.
10. The rejection of claims 51-54, 57, 60-68 under 35 U.S.C. 102(a) as being anticipated by Kingsman et al (WO 98/55607, published 12/10/98) is withdrawn in view of the removal of Alan Kingsman from the application as an inventor.

Response to Arguments

11. The rejection of claims 60, 62, 64 are rejected under 35 U.S.C. 112, second paragraph, part c in the previous office action, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention is maintained.

The response filed 7/12/04 has been carefully considered but is deemed not to be persuasive. The response states that "hybridizing" is broad but not indefinite (see page 5 of response). In response to this argument, claim 60 has been amended to recite "stringent conditions", but this is still indefinite because the full set of conditions is

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not specified. Are the conditions set forth as those in the specification on page 20, line 25-26 or some other conditions. Without a full set of conditions the metes and bounds of the claims are indefinite.

12. The rejection of claims 60, 62, 64 under 35 U.S.C. 112, first paragraph, is maintained.

The response filed 7/12/04 has been carefully considered but is deemed not to be persuasive. The response states that the claims no longer recite variant, homologue, or derivative (see page 8 of response). In response to this argument, while this may be true, claim 60 still encompasses nucleic acids that hybridize to SEQ ID NO:5 coding strand and encodes a ScFv. It is not possible for the nucleic acid that hybridizes to SEQ ID NO:5 coding strand to encode a ScFv that binds 5T4 antigen. It is also known that one could not produce a ScFv with just any DNA that hybridizes to or is complementary to the DNA of SEQ ID NO:5. The specification has not taught how to produce such ScFv with such nucleotide sequence in a host cell.

Therefore, in view of the lack of guidance in the specification and in view of the discussion above one of skill in the art would be required to perform undue experimentation in order to practice the claimed invention.

Conclusion

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13. Claims 52-54, 57, 61, 63, 65-66, 68 are in condition for allowance.

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Larry R. Helms, Ph.D, whose telephone number is (571) 272-0832. The examiner can normally be reached on Monday through Friday from 6:30 am to 4:00 pm, with alternate Fridays off. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffery Siew, can be reached at (571) 272-0787.

16. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center. The faxing of such papers must conform with the notice published in the Official Gazette,

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1096 OG 30 (November 15, 1989). The Fax Center telephone number is 703-872-9306.

Larry R. Helms

571-272-0832

A handwritten signature in black ink, consisting of stylized, overlapping loops and a long horizontal stroke at the end.

LARRY R. HELMS, PH.D
PRIMARY EXAMINER